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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,304	10/22/2003	Terence Chen	CFP-2237 (15722/581)	2251
23595	7590	01/05/2005	EXAMINER	
NIKOLAI & MERSEREAU, P.A. 900 SECOND AVENUE SOUTH SUITE 820 MINNEAPOLIS, MN 55402			GEHMAN, BRYON P	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 01/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/691,304	CHEN, TERENCE	
	Examiner	Art Unit	
	Bryon P. Gehman	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 -12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 4, "the holder" is inconsistent with the immediately preceding "at least one holder". See also claims 5 and 6. In line 6, "the tool" lacks antecedent basis for one such tool.

In claim 4, line 2, "extending" should be --extends-- to be grammatical.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Krivec (5,535,881). Claims 1-6 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by McCann (5,598,924). Claims 1-4 and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Ernst (5,638,964). Claims 1-4 and 9-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Ernst (2002/0121491). Each

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discloses a tool-holding apparatus comprising a board (30; 20; 3; 1; respectively) and at least one holder (35 and 40; 30; 8'; 6), each holder comprising a root (40; 31; 4'; 7), a tip (35; 32; 5'; 8) extending from the root to press a tool, a restraint (at 37; 33; 54'; 9) formed near the tip for restraining the tool and a concave portion (between adjacent elements 35 and 40 of different holders; between 33 and the bottom between two roots; between adjacent roots; at 16) near the root to receive the tool.

As to claims 2 and 3, each discloses multiple paired holders, each pair to hold a single tool.

As to claim 4, each discloses each root extending from the board.

As to claims 5 and 6, Krivec and McCann each disclose a substantially horizontal section (45; 32) and an inclined portion (35 or 37; 33).

As to claims 7 and 8, Krivec discloses a tip (38) extending obliquely from the inclined section (at 37).

As to claim 9, Krivec and the Ernst references each disclose the restraint including an obtuse protrusion (37; 54'; at 9).

As to claim 10, each discloses first and second facets (51 and portion adjacent thereto; two surfaces at a 90 degree angle to each other; two surfaces at a 90 degree angle to each other; two surfaces at 16 at 90 degree angles to each other).

As to claim 12, McCann and Ernst each disclose an ear (21; 2 and 3).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Ernst reference. To modify the shape of the Ernst holders to comprise a horizontal section would have been a matter of design choice, as the shape is not seen to unobviously distinguish from the structure disclosed by Ernst.

As to claim 6, each Ernst reference discloses an inclined portion (at 7'; at 8).

As to claims 7 and 8, each Ernst reference discloses a tip (free end of 5'; 9) extending obliquely from the inclined section.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown are similar tool-holding apparatus.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Disclosed are similar tool-holding apparatus.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571) 272-4555. The examiner can normally be reached on Monday through Wednesday from 5:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-4555.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bryon P. Gehman
Primary Examiner
Art Unit 3728

BPG